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Delbert J Barnard
Barnard & Pauly PS
PO Box 58888
Seattle, WA 98138-1888

EXAMINER

LEE, SIN J

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,755

Applicant(s)

GRATE ET AL.

Examiner

Sin J Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 12-19, 25-31, 38-42, 44, 166, 168 and 169 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 204 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 9-11, 20-24, 43, 46-50, 101-104, 106, 147-151, 153, 154, 202 and 203 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other:

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4,6-31,38-50,101-104,106,147-151,153,154,166,168,169 and 202-204.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,2,4,6-31,38-50,101-104,106,147-151,153,154,166,168,169 and 202-204.

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DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 204 and 205 have been renumbered as claims 203 and 204 respectively.

2. Upon reconsideration, the previously made restriction requirement between the Group I and Group II inventions are hereby withdrawn since the Examiner does recognize that the search for Group I would overlap with the search for Group II. However, the election of species-requirement still stands because there are many different possible combinations of the first precursor molecule and the second precursor molecule and each different combination would require different search. Since applicants elected the species represented by Example 1 (a combination of a polymer consisting of polydimethylsiloxane with *terminal vinyl groups* (as the second precursor molecule) and a copolymer of dimethylsiloxane and hydromethylsiloxane (HMS-301 is a copolymer of dimethylsiloxane and hydromethylsiloxane) which has silicon hydride groups *distributed along the chain* (as the first precursor molecule)), all the claims related to this combination, i.e., claims 1, 2, 4, 9-11, 20-24, 43, 45-50, 101-104, 106, 147-151,

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153, 154, 202-204 are being examined. Accordingly, claims 6-8, 12-19, 25-31, 38-42, 44, 166, 168, and 169 are hereby withdrawn from further consideration as being drawn to nonelected species.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is written to depend from claim 5. However, claim 5 has been canceled by applicants. For the purpose of examining the claim on the merit, the Examiner interpreted present claim 9 to depend from claim 4 (since the canceled claim 5 was depending from claim 4). ✓

Appropriate correction is required.

5. Claim 153 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 153 is written to depend from claim 152, however, claim 152 has been canceled by applicants. For the purpose of examining the claim on the merit, the Examiner interpreted present claim 153 to depend from claim 149 (since the canceled claim 152 was depending from claim 149). Appropriate correction is required. ✓

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, 9-11, 20-24, 43, 46, 103, 106, and 147 are rejected under 35 U.S.C. 102(b) as being anticipated by Cavezzan et al (4,939,065).

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Cavezzan teaches (see col.1, lines 8-12, col.4, lines 15-38, Example 1) a UV-crosslinkable organopolysiloxane composition containing diorganopolysiloxane having at least 2 alkenyl unsaturation (preferably vinyl unsaturation), which can be located at the end of the polymer chain. As examples for the organic radical (as in diorgano group of diorganopolysiloxane), Cavezzan lists methyl, ethyl, phenyl and 3,3,3-tri-fluoropropyl radicals. Since there are only several choices, one of ordinary skill in the art would immediately envisage a dimethylpolysiloxane having two vinyl unsaturation which are located at the end of the polymer chain as Cavezzan's diorganopolysiloxane component. Besides, in Example 1, Cavezzan actually uses a polydimethylsiloxane polymer having dimethylvinylsiloxyl *end* groups. ↓
and
precursor. Therefore, Cavezzan teaches present second precursor molecule of claims 1, 4, 9-11, 103, and 106.

Cavezzan's organopolysiloxane composition also contains (see col.3, lines 37-62, col.4, lines 53-68, col.5, lines 1-6) a second component, an organohydropolysiloxane containing at least two hydrogen atoms bonded to a silicon atom wherein the SiH groups may be located within the polymer chain, and as one of only three examples, Cavezzan lists *polydimethylpolymethylhydrosiloxane copolymers* having trimethylsiloxyl end groups (*which indicates that the SiH groups are located not at the chain ends of the polymer but within the polymer chain*). Since there are only a few examples, one of ordinary skill in the art would immediately envisage the polydimethylpolymethylhydrosiloxane copolymers having

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trimethylsiloxyl end groups as Cavezzan's second component. Therefore, the prior art teaches present first precursor molecule of claims 1, 20-24, 103, and 106.

Cavezzan's organopolysiloxane composition finally contains a platinum catalyst (see col.3, lines 37-62, col.5, lines 45-56). Therefore, the prior art teaches present photoactivatable catalyst of claims 1 and 103.

Cavezzan teaches (col.3, lines 37-41) that his invention features, as a negative resist, a *film-forming* organopolysiloxane composition capable of being *crosslinked by hydrosilylation* in the presence of a catalyst derived from a platinum group metal. Cavezzan furthermore teaches (col.7, lines 59-68, col.8, lines 1-16, lines 42-50) that his substrate (e.g., silicon wafer) is coated with a uniform adherent film of his organopolysiloxane composition, and then the film formed is imagewise irradiated with ultraviolet radiation which will cause the exposed area to cure, while the unirradiated area remains soluble in organic solvents. Therefore, the prior art teaches present inventions of claims 1, 4, 9-11, 20-24, 43, 46, 103, 106, and 147. Since the prior art teaches present methods of claims 1 and 103, it is the Examiner's position that Cavezzan's composition after the imagewise exposure and development steps will inherently become a chemically selective solvent film as presently cited.

9. Claims 2 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan et al (4,939,065) as applied to claims 1 and 103 above, and further in view of Oxman et al (5,145,886).

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Cavezzan et al with respect to claims 1 and 103 are discussed above in Paragraph 8. Cavezzan does not teach present Pt(II) bis(beta-diketonates). Oxman teaches (col.3, lines 22-40) that when Pt (II) beta-diketonate complex is used as hydrosilation catalyst, the reaction composition will not react prematurely in the absence of actinic radiation, the reaction composition allows the cure of unusually thick sections of material, and low levels of the catalyst can be used. In view of Oxman's teaching, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use Pt (II) beta-diketonate complex as Cavezzan's hydrosilation catalyst in order to take those advantages of using such catalyst as taught by Oxman, i.e., the reaction composition will not react prematurely in the absence of actinic radiation, the reaction composition allows the cure of unusually thick sections of material, and low levels of the catalyst can be used. Therefore, Cavezzan in view of Oxman would render obvious present invention of claims 2 and 104.

10. Claims 48-50, 101, 149-151, 153, 154, and 202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan et al (4,939,065) in view of Oxman et al (5,145,886) and Sachdev et al (5,470,693).

Cavezzan is discussed above in Paragraph 8. As shown above, Cavezzan teaches present inventions of claims 48 and 149 except for the present step of cleaning the substrate and reacting a coupling agent with the surface of the substrate that appends to the surface reactive groups that can participate in hydrosilylation reactions. Oxman teaches (col.8, lines 53-67) that when a hydrosilation composition is applied to the surface of a solid substrate, it is often advantageous to

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prime the surface of the substrate to which the hydrosilation composition is to be applied to improve the adhesion of the composition to the substrate. Oxman furthermore states that *many primers are described in the art and should be chosen on the basis of the substrate to be used.*

As discussed above, Cavezzan's substrate is a silicon wafer. Sachdev teaches plasma-cleaning of a silicon wafer and then treating it with a primer, gamma-aminopropyl-triethoxysilane (as an adhesion promoter). In view of the teachings of Oxman and Sachdev, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to clean Cavezzan's silicon wafer and then treat it with gamma-aminopropyl-triethoxysilane (present coupling agent compound of claims 50 and 151) before the hydrosilation composition is applied to the wafer so as to improve the adhesion of the hydrosilation composition to the silicon wafer as taught by Oxman and Sachdev. Therefore, Cavezzan in view of Oxman and Sachdev would render obvious present inventions of claims 48-50, 101, 149-151, 154, and 202. Since the gamma-aminopropyl-triethoxysilane is present coupling agent compounds of claims 50 and 151, it is the Examiner's position that when one primes the surface of Cavezzan's silicon wafer with the gamma-aminopropyl-triethoxysilane, it will inherently append to the surface of the silicon wafer reactive groups that can participate in hydrosilylation reactions as presently cited.

With respect to present claim 153, Cavezzan does not teach present Pt(II) bis (acetylacetonate). Oxman teaches (col.3, lines 22-40, col.9, lines 49-51) that when Pt (II) beta-diketonate complex such as Pt(II)acetylacetonate is used as hydrosilation catalyst, the reaction composition will not react prematurely in the absence of actinic radiation, the reaction

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composition allows the cure of unusually thick sections of material, and low levels of the catalyst can be used. In view of Oxman's teaching, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use Pt (II) acetylacetonate as Cavezzan's hydrosilation catalyst in order to take those advantages of using such catalyst as taught by Oxman, i.e., the reaction composition will not react prematurely in the absence of actinic radiation, the reaction composition allows the cure of unusually thick sections of material, and low levels of the catalyst can be used. Therefore, Cavezzan in view of Oxman and Sachdev would render obvious present invention of claim 153.

11. Claims 1, 2, 4, 9-11, 20-24, 43, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Oxman et al (5,145,886).

Oxman teaches (Example 1) a composition containing (I) a vinyl terminated polydimethylsiloxane which formula is shown in col.9, lines 30-36, (ii) a polydimethylpolymethylhydrosiloxane copolymer (wherein SI-H groups are located along the polymer chain) which formula is shown in col.9, lines 40-46, and (iii) a photohydrosilation catalyst which is a Pt(II) beta-diketonate complexes. Therefore, the prior art teaches present second precursor molecule of claims 1, 4, 9-11, present first precursor molecule of claims 1, 20-24, and present photoactivatable catalyst of claims 1 and 2. After applying his hydrosilation composition to a substrate, the coated substrate is exposed to radiation in order to be cured (see col.8, lines 11-18, lines 53-60). Therefore, the prior art teaches present inventions of claims 1, 2, 4, 9-11, 20-24, 43, and 46. Since Oxman teaches present method of claim 1, it is the Examiner's

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position that Oxman's composition will inherently become a chemically selective sorbent film after the irradiation step as presently cited.

12. Claims 48-50 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oxman et al (5,145,886) in view of Murai et al (4,243,718).

Oxman is discussed above in Paragraph 11. Oxman teaches (col.8, lines 53-60) that his substrate can be paper, cardboard, wood, cork, plastic (such as polyester, nylon, polycarbonate), fabric, metal, glass, or ceramic. Since there are only several choices, one of ordinary skill in the art would immediately envisage polyester as Oxman's substrate. Oxman furthermore teaches (col.8, lines 61-68, col.9, lines 1-2) that it is advantageous to prime the surface of a substrate to which his hydrosilation composition is to be applied to improve the adhesion of the composition to the substrate and that the epoxy-functional siloxane *as taught in Murai et al* are useful for priming the surface of plastic films such as polyester. As examples for the epoxy-functional siloxane, Murai teaches (col.2, lines 10-16) gamma-glycidoxypentyltrimethoxysilane, gamma-glycidoxypentyltriethoxysilane, and beta-(3,4-epoxycyclohexyl) ethyltrimethoxysilane (all of which are present trimethoxysilane coupling agent or present triethoxysilane coupling agent of claim 50). Also, in Example 1, Murai applies the primer composition containing the epoxy-functional siloxane to a substrate by brush after washing the substrate with 1,2,2-tri-fluoro-1,2,2-trichloroethane. In view of the teachings of Oxman and Murai, it would have been obvious to one of ordinary skill in the art to prime the surface of Oxman's polyester substrate with the epoxy-functional siloxane (present trimethoxysilane and triethoxysilane coupling agent) as taught

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by Murai (after washing Oxman's substrate) in order to improve the adhesion of Oxman's composition to the polyester substrate. Therefore, Oxman in view of Murai would render obvious present inventions of claims 48-50 and 101. Since Oxman in view of Murai teaches present coupling agent of claim 50, it is the Examiner's position that when one primes the surface of Oxman's polyester substrate with Murai's epoxy-functional siloxane, it will inherently append to the surface of the substrate reactive groups that can participate in hydrosilylation reactions as presently cited.

Cancel.
13. Claims 47 and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al (5,262,192).

Nelson teaches (col.6, lines 3-29) manufacturing a chemical sensor, specifically an optical fiber microsensor for measuring blood oxygen partial pressure of oxygen intravascularly. The microsensor is prepared with a dye copolymer matrix that comprises a *methylhydrosiloxane copolymer* (which has Si-H groups) to which polynuclear aromatic dye materials are covalently linked. A *crosslinking catalyst such as platinum* is preferably present to catalyze *hydrosilation* of the dye copolymer to the *vinyl functional polydimethylsiloxane*. Nelson manufactures the optical fiber microsensor in the following steps (see col.6, lines 57-68, col.7, lines 1-26): An optical fiber is first *cleaned* and dried. The tips of the optical fiber is next dipped in a primer such as *vinyltriethoxysilane* for improving bonding of the matrix material to the optical fiber. Then the optical fiber tip is dipped in the dye copolymer matrix material described above, which adheres to the prepared surface of the optical fiber, for

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preparation of oxygen sensor. The matrix material on the optical fiber is then *cured* by exposure of the optical fiber tip to an elevated temperature of from 140° to about 240°C for 10-60 seconds.

Therefore, Nelson teaches present methods of claims 1 and 48 except for the step of exposure to *light* to achieve hydrosilylation. However, present claims 47 and 102 are product-by-process claims. Although in Nelson, the hydrosilylation is achieved by heating instead of exposure to light, Since Nelson makes a chemical sensor comprising the hydrosilylation product by using the presently claimed reactants, it is the Examiner's position that the prior art still teaches the present inventions of claims 47 and 102. See MPEP 2113. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

14. Claim 148 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan et al (4,939,065) as applied to claim 103 above, and further in view of Nelson et al (5,262,192).

Cavezzan et al with respect to claim 103 is discussed above in Paragraph 8.

As discussed above, Cavezzan teaches a UV crosslinkable organopolysiloxane composition containing diorganopolysiloxane (with at least 2 vinyl unsaturation at the end of the polymer chain), polydimethylpolymethylhydrosiloxane copolymer having Si-H groups located within the polymer chain, and a platinum catalyst. Cavezzan teaches imagewise irradiating the

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organopolysiloxane composition-coated substrate with UV in order to achieve hydrosilylation and then dissolving the unexposed areas in a solvent. Nelson teaches (see Paragraph 13 above) making a chemical sensor using the hydrosilylation product made from the similar reactants as Cavezzan's (i.e., methylhydrodimethylsiloxane copolymer (which has Si-H groups), a platinum crosslinking catalyst, and vinyl functional polydimethylsiloxane). Since both of the prior arts teaches very similar reactants for hydrosilylation reaction, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to make a chemical sensor using Cavezzan's UV crosslinkable organopolysiloxane composition because Nelson clearly teaches that such composition can be used in manufacturing a chemical sensor. Therefore, Cavezzan in view of Nelson would render obvious present invention of claim 148.

15. Claim 203 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan et al (4,939,065) in view of Oxman et al (5,145,886) and Sachdev et al (5,470,693) as applied to claim 149 above, and further in view of Nelson et al (5,262,192).

Cavezzan in view of Oxman and Sachdev with respect to claim 149 is discussed above in Paragraph 10.

As explained above, Cavezzan in view of Oxman and Sachdev teaches cleaning Cavezzan's substrate and then treating it with gamma-aminopropyl-triethoxysilane before the hydrosilation composition is applied to the substrate so as to improve the adhesion of the hydrosilation composition to the substrate. As discussed in Paragraph 13 above, Nelson teaches making a chemical sensor using the hydrosilylation product made from the similar reactants as

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Cavezzan's (Nelson also teaches cleaning his substrate and treating it with a primer such as *vinyltriethoxysilane* for improving bonding of his matrix material to the substrate). Since both of the prior arts teaches very similar reactants for hydrosilylation reaction, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to make a chemical sensor using Cavezzan's UV crosslinkable organopolysiloxane composition because Nelson clearly teaches that such composition can be used in manufacturing a chemical sensor. Therefore, Cavezzan in view of Oxman and Sachdev, and further in view of Nelson would render obvious present invention of claim 203.

16. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims since neither of Cavezzan and Oxman teaches or suggests the use of hydromethyldimethylsiloxane having 25% of hydromethyl groups.

17. Claim 204 is allowed. None of the cited prior arts teaches or suggests the step of repeating the processes of imagewise exposure and development using new compositions at different locations each time as presently claimed in claim 204.

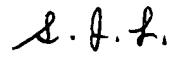
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is (703) 305-0504. The examiner can normally be reached on Monday-Friday from 8:30 am EST to 5:00 pm EST.

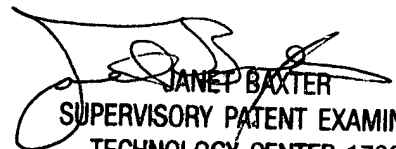
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the

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organization where this application or proceeding is assigned is (703) 872-9311 for after final responses or (703) 872-9310 for before final responses.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.


S. Lee
July 29, 2002


JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700